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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,554	02/19/2002	Yumiko Seki	500.41210X00	1472
24956	7590	01/10/2008		
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			EXAMINER VIG, NARESH	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 01/10/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/076,554

Applicant(s)

SEKI ET AL.

Examiner

Naresh Vig

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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DETAILED ACTION

This is reference to communication received 19 October 2007. Claims 3 – 5 and 8 are pending for examination.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. JP 2001-212365, filed on 11 March 2001.

Response to Arguments

Applicant's arguments and concerns are for amended claims which have been responded to in response to pending claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 – 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

On claim 3, line 5 – 10 and claim 8, line 5 – 10, applicant recites the limitation acquiring information on a world-wide standard

On claim 3, line 9 and claim 8, line 9, applicant recites the limitation acquiring information on published applications and examinations unique to each country

On claim 3, line 26 and claim 8, line 26, applicant recites the limitation acquiring information on documents which have been applied in a certain country, and information on documents which have accepted permission from said certain country as a result of examinations after application; and

claim 3, line 29 and claim 8, line 29, applicant recites the limitation automatically preparing an application for another country, other than said certain country, with reference to said information on the documents

As currently claimed, it is not clear which information is used to prepare the documents.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Stiffler US Publication US 2002/0198752.

Regarding claims 3 and 8, as best understood by examiner, ZipForm teaches system and method for assisting a user in preparing application documents for making a document-based application. ZipForm teaches preparing documents in compliance to specific governing entity of a country like USA.

Even though does not specifically teach acquiring information on a world-wide standard which defines contents that should be described in said document-based application. However, ZipForm does teach to get information at jurisdictional level [ZipForm page 22], and also ZipForm teaches Data Template [page 12]. Stiffler teaches system and method for facilitating international shipments of goods that enable centralized control of both the establishment of and any changes to international shipping requirements (i.e. Stiffler has to acquire world-wide standards to be able to

facilitate international shipment of goods) [Stiffler, Fig. 9 – 11 and disclosure associated with the figures]..

Therefore, at the time of invention, it would have been obvious to one of ordinary skill in the art to modify ZipForm by adopting the teachings of Stiffler to be able to use the previously stored customer information for generating documents of other governing entities.

ZipForm in view of Stiffler teaches capability for :

acquiring information on a standard unique to each country which is defined in detail in conformity to said world-wide standard, and information on published applications and examinations unique to each country (teaches to acquire information from plurality of documents for plurality of jurisdiction) [ZipForm page 18, set for form for South Dakota Area and Kokomo Area];

acquiring information on published applications and examinations unique to each country;

accepting conditions associated with the application documents to be prepared and accepting a user selected country, wherein the conditions [ZipForm, e.g. contract, listing, leasing] and the country [ZipForm, state, county, Stickler, Fig. 9 and disclosure associated with the Fig] are specified by the user;

assisting to prepare said application documents based on said acquired information on the world-wide standard, information on the standard unique to each country, said information on the published applications and examinations, and said conditions associated with the application documents to be prepared;

examining said application documents to check whether any of said application documents include an item which violates examination criteria for said user selected country;

preparing the application documents for said user selected country to comply with an application format and examination conditions in said user selected country such that none of said application documents include any item violating said examination criteria including a quantity of a component in the application documents [Stiffler, Fig. 9 and disclosure associated with the Fig, Stiffler teaches capability for preparing and providing compliance country specific requirements to user];

acquiring information on documents which have been applied in a certain country, and information on documents which have accepted permission from said certain country as a result of examinations after application [ZipForm maintains current documents]; and

automatically preparing an application for another country, other than said certain country, with reference to said information on the documents [ZipForm teaches capability for preparing documents for plurality of jurisdictions],

wherein said another country, other than said certain country, is a user- specified country.

Regarding claim 4, ZipForm in view of Stiffler teaches capability for electronically submitting the prepared application documents to perform electronic application processing.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over ZipForm (document labeled as Information on ZipForm) in view of Stiffler US Publication US 2002/0198752 and further in view of Abbruzzese et al. US Patent 5557515 hereinafter known as Abbruzzee.

Regarding claim 5, ZipForm in view of Stiffler does not teach recording an entire manipulation procedure of an operator for preparing an application with the assistance of application preparation as log information so that the log information can be viewed at a later time. However, Abbruzzese teaches an electronic activity log function maintains a record of key activities involved in the processing of work items [abstract].

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify ZipForm in view of Stiffler by adopting teachings of Abbruzzese to automatically and securely maintain a record of the activities of all staff members in work processing.

Conclusion

Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nareşh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on Mon-Thu 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read "Naresh Vig". The signature is stylized with a large, looped initial "N" and a cursive "Vig".

Naresh Vig
Examiner
Art Unit 3629

January 7, 2008